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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/656,479

09/04/2003

Jonathan Helitzer

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ROPES & GRAY LLP

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/656,479	Applicant(s) HELITZER ET AL.	
	Examiner Natalie A. Pass	Art Unit 3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44, 47, 54-57 and 61-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44, 47, 54-57, 61-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 22 June 2009 has been entered.

2. This communication is in response to the Request for Continued Examination and the amendment filed on 22 June 2009. Claims 1-43, 45-46, 48-53, 58-60 have been cancelled. Claims 44, 47, 54, 56, 61-63 have been amended. Claims 44, 47, 54-57, 61-63 remain pending.

Claim Rejections - 35 USC §§ 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 44, 47, 54, 56, 61, are rejected under 35 U.S.C. § 102(e) as anticipated by Farmer, U.S. Patent Application Publication Number 2004/0139034.

(A) As per claim 61, Farmer teaches a method for insuring a building structure by taking into account technologies that militate against loss comprising:

maintaining a database identifying a plurality of technologies that reduce risk of loss to an associated building structure (Farmer; paragraphs [0001], [0011]-[0012], [0044]);

issuing an insurance policy, by an insurance company, covering a building structure that incorporates a sensor technology from the plurality of technologies identified in the database (Farmer; paragraph [0001], [0011]-[0012], [0028], [0044]), wherein the incorporated sensor technology is capable of outputting data electronically (Farmer; paragraphs [0027], [0029]);

obtaining monitoring data, by the insurance company, indicating “potential maintenance problems” (reads on “a dangerous condition”) of the building, based on data output electronically by the incorporated technology (Farmer; paragraphs [0026], [0038], [0043]);

inputting or “capturing” the monitoring data into a computer system (Farmer; paragraph [0026]);

the computer system determining an alteration to a premium for the insurance policy based on the condition of the building indicated in the monitoring data (Farmer; paragraph [0026]); and

the computer system altering the premium of the issued insurance policy based on the determination (Farmer; paragraphs [0011], [0026], [0029], claim 5); Examiner interprets Farmer’s teachings of “policy-premium adjustments ... [...] ... could be discounts provided for electing specific monitoring options, or adjustments based on analysis of the data monitored and communicated to the insurance company” (Farmer; paragraph [0026]) together with Farmer’s

teachings of “[i]n an embodiment of the invention, the Website [the computer system] 20 may be provided with information from member insurance companies 22, relating to each of their calculations for proposing insurance coverage to a customer. Such analysis will include providing policy premium adjustments based upon the actual operation of the vehicle ... [...] ...” (Farmer; paragraph [0029]) to teach a form of “the computer system altering the premium of the issued insurance policy based on the determination.”

As per the recitation in claim 61 of a “building structure,” Farmer clearly teaches “[t]he present invention is related generally to a system and method for monitoring various types of information relating to the operation of vehicles, building systems, or monitoring of other personnel or environments” (Farmer; paragraph [0001]), and Farmer teaches “effective capturing of ... [...] ... configuration and operational data for determining possible ... [...] ... insurance premium discounts ... [...] ... A similar approach may be provided for other environments, such as the home, office, other places of business or the like, where a user, other people or the environment may be monitored, data captured and products or services related to the user, others or the environment correlated and communicated in a similar fashion (Farmer; paragraph [0012]), and Farmer also teaches “[i]n an alternative embodiment, the systems and methods of the invention may be used in differing applications or environments. As merely another example of this, as with the vehicle monitoring environment described above, the invention may be applicable to monitor home or building systems and operation” (Farmer; paragraph [0044]). It is respectfully submitted that since Farmer is directed to “provid[ing] the ability to monitor the user or environment to allow the capture of data, which can be

communicated to an electronic marketplace to calculate the cost of related products or services to the user within such an environment” (Farmer; paragraph [0011]), the building systems and environments of Farmer, as recited in the above passages, broadly reads on the claimed “building structures.”

Moreover, Examiner notes that the monitoring system recited is intended for use in a building structure, and courts have determined that a claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

(B) Claim 44 differs from method claim 61, in that it is a system rather than a method for insuring a building structure by taking into account technologies that militate against loss.

Amended system claims 44, 54 repeat the subject matter of claims 61, 61, respectively, as a set of elements rather than a series of steps. As the underlying processes of claim 61 have been shown to be fully disclosed by the teachings of Farmer in the above rejection of claim 61, it is readily apparent that the system disclosed by Farmer includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 61, and incorporated herein.

(C) Claim 47 differs from method claim 61, in that it is a system rather than a method for insuring a building structure by taking into account technologies that militate against loss.

Amended system claims 47, 56 repeat the subject matter of claims 61, 61, respectively, as a set of elements rather than a series of steps. As the underlying processes of claim 61 have been

shown to be fully disclosed by the teachings of Farmer in the above rejection of claim 61, it is readily apparent that the system disclosed by Farmer includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 61, and incorporated herein.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 55, 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farmer, U.S. Patent Application Publication Number 2004/0139034 in view of Underwood et al., U.S. Patent Number 5873066.

(A) As per claims 55, 57, Farmer teaches a system including premium ranges, however fails to explicitly disclose a system wherein the insurance policy includes an attachment point, and the premium alteration determination is further based on the attachment point.

However, these features are well-known in the art as evidenced by Underwood.

In particular, Underwood teaches a system

wherein the insurance policy includes an attachment point, and the premium alteration determination is further based on the attachment point (Underwood; column 6, lines 11-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Farmer to include these limitations, as taught by Underwood, with the motivations of providing “a system for quoting, binding and later issuing an excess insurance contract in which all relevant information pertaining to the risk is properly documented and permanently stored. ... [...] ... and which requires the quoted premium to accurately reflect the risks associated with a policy” (Underwood; column 1, lines 59 to column 2, line 1).

7. Claims 62-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farmer, U.S. Patent Application Publication Number 2004/0139034 in view of Burge, U.S. Patent Application Publication Number 2002/0111725.

(A) As per claim 63, Farmer teaches a method for insuring a building structure by taking into account technologies that militate against loss comprising:

maintaining a database identifying a plurality of technologies that reduce risk of loss to an associated building structure (Farmer; paragraphs [0001], [0011]-[0012], [0028], [0044]);

issuing an insurance policy, by an insurance company, covering a building structure that incorporates at least first and second sensor technologies from the plurality of technologies identified in the database (Farmer; paragraph [0001], [0011]-[0012], [0044]), wherein each incorporated sensor technology is capable of outputting data electronically (Farmer; paragraphs [0027], [0029]);

obtaining monitoring data, by the insurance company, indicating a condition of the building, based on data output electronically by the first and second incorporated sensor technologies (Farmer; paragraph [0026], [0038], [0043]);

inputting or “capturing” the monitoring data into a computer system (Farmer; paragraph [0026]); and

the computer system altering the premium of the issued insurance policy based on the determination (Farmer; paragraphs [0011], [0026], [0029], claim 5); Examiner interprets Farmer’s teachings of “policy-premium adjustments ... [...] ... could be discounts provided for electing specific monitoring options, or adjustments based on analysis of the data monitored and communicated to the insurance company” (Farmer; paragraph [0026]) together with Farmer’s teachings of “[i]n an embodiment of the invention, the Website [the computer system] 20 may be provided with information from member insurance companies 22, relating to each of their calculations for proposing insurance coverage to a customer. Such analysis will include providing policy premium adjustments based upon the actual operation of the vehicle ... [...] ...” (Farmer; paragraph [0029]) to teach a form of “the computer system altering the premium of the issued insurance policy based on the determination.”

As per the recitation in claim 63 of a “building structure,” Farmer clearly teaches “[t]he present invention is related generally to a system and method for monitoring various types of information relating to the operation of vehicles, building systems, or monitoring of other personnel or environments” (Farmer; paragraph [0001]), and Farmer teaches “effective capturing of ... [...] ... configuration and operational data for determining possible ... [...] ...

insurance premium discounts ... [...] ... A similar approach may be provided for other environments, such as the home, office, other places of business or the like, where a user, other people or the environment may be monitored, data captured and products or services related to the user, others or the environment correlated and communicated in a similar fashion (Farmer; paragraph [0012]), and Farmer also teaches “[i]n an alternative embodiment, the systems and methods of the invention may be used in differing applications or environments. As merely another example of this, as with the vehicle monitoring environment described above, the invention may be applicable to monitor home or building systems and operation” (Farmer; paragraph [0044]). It is respectfully submitted that since Farmer is directed to “provid[ing] the ability to monitor the user or environment to allow the capture of data, which can be communicated to an electronic marketplace to calculate the cost of related products or services to the user within such an environment” (Farmer; paragraph [0011]), the building systems and environments of Farmer, as recited in the above passages, broadly reads on the claimed “building structures.”

Farmer fails to explicitly disclose

the computer system applying a first weighting to data received from the first incorporated sensor technology and a second weighting, different from the first weighting, to data obtained from the second incorporated sensor technology; and

the computer system determining an alteration to a premium for the insurance policy based on the condition of the building indicated in the monitoring data and the first and second weightings.

However, these features are well-known in the art as evidenced by Burge.

In particular, Burge teaches a method comprising the computer system applying a first weighting to data received from the first incorporated sensor technology and a second weighting, different from the first weighting, to data obtained from the second incorporated sensor technology (Burge; paragraphs [0150], [0185], [0201]-[0203]); and

the computer system determining an alteration to a premium for the insurance policy based on the condition of the building indicated in the monitoring data and the first and second weightings (Burge; paragraph [0202]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Farmer to include these limitations, as taught by Burge, with the motivations of using “Weighting Factors 1435 ... [...] ... when Risk Measure 1240 data is unable to completely isolate the risk of a single operating characteristic from other operating characteristics. Additionally, different Insurance Companies 190 may place different weights on particular operating characteristics ... [and] ... to allow different Insurance Companies 190 to select their own set of Weighting Factors 1435 to calculate different Safety Scores 870 for the purposes of determining insurance discounts (Burge; paragraph [0202]).

(B) Claim 62 differs from method claim 63, in that it is a system rather than a method for insuring a building structure by taking into account technologies that militate against loss.

Amended system claim 62 repeats the subject matter of claim 63, respectively, as a set of elements rather than a series of steps. As the underlying processes of claim 63 have been shown

to be fully disclosed by the collective teachings of Farmer and Burge in the above rejection of claim 63, it is readily apparent that the system disclosed collectively by Farmer and Burge includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 63, and incorporated herein.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references, Bauer et al., U.S. Patent Application Publication Number 2004/0153362, Nakagawa et al., U.S. Patent Application Publication Number 2002/0128882 teach the environment of reducing insurance risk.

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/N. A. P./
Examiner, Art Unit 3686
September 8, 2009

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686